

**REMARKS**

The Examiner rejected claims 1-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Yamamoto et al. (6,628,890), in further view of Thomason et al. (6,018,612).

Applicants respectfully traverse the §103 rejections with the following arguments.

35 U.S.C. §103

The Examiner rejected claims 1-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Yamamoto et al. (6,628,890), in further view of Thomason et al. (6,018,612).

Applicants respectfully contend that claims 1, 9, and 15 are not unpatentable over Yamamoto in further view of Thomason, because Yamamoto in further view of Thomason does not teach or suggest each and every feature of claims 1, 9, and 15.

As a first example of why Yamamoto in further view of Thomason does not teach or suggest each and every feature of claims 1, 9, and 15, Yamamoto in further view of Thomason does not teach or suggest the feature: "receiving means for receiving first compressed data composed of a plurality of packets, said first compressed data including a **plurality of programs multiplexed in a time division manner**" (emphasis added).

The Examiner quotes Yamamoto, col 4, lines 57-63 as reciting: "The demodulation/error correction unit 2 performs demodulation and error correction for the bitstream input from the tuner 1, converts the same into a transport stream [TS] defined by MPEG2 system, and output the TS to the demultiplexer unit 3. The demultiplexer unit 3 demultiplexes an audio or video PES packet of one program from the TS input".

In response, Applicants contend that Yamamoto does not disclose that the bitstream input from the tuner 1 comprises a **plurality of programs** (i.e., at least two programs). In addition, Yamamoto does not disclose that the plurality of programs are multiplexed in a **time division manner**.

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As a second example of why Yamamoto in further view of Thomason does not teach or suggest each and every feature of claims 1, 9, and 15, Yamamoto in further view of Thomason does not teach or suggest the feature: "record control means for **generating** second compressed data including the compressed audio/video data extracted by the data separating means" (emphasis added).

The Examiner quotes Yamamoto, col 4, line 67 - col. 5, line 2 as reciting: "The PES packet storage block 8 **records** the audio or video PES packet input from the demultiplexer unit 3, in the AN-HDD1" (emphasis added).

In response, Applicants contend that the preceding quote from Yamamoto discloses that the demultiplexing a single PES packet of one program, PES packet storage block 8 **records** the audio or video PES packet which does not satisfy the limitation of **generating** second compressed data including the compressed audio/video data extracted by the data separating mean. In other words, "generating" and "recording" have different functions. Yamamoto does not disclose the "generating" limitation in the preceding feature of claims 1, 9, and 15.

As a third example of why Yamamoto in further view of Thomason does not teach or suggest each and every feature of claims 1, 9, and 15, Yamamoto in further view of Thomason does not teach or suggest the feature: "time division control means for controlling the transmitting and reading of the second compressed data to and from the recording means in a time division manner".

The Examiner alleges that Thomason discloses the preceding feature of claims 1, 9, and 15, and argues as follows why it is obvious to modify Yamamoto with the alleged teaching of

Thomason: "As taught by Thomason et al, time division multiplexing of a read/write head allows for apparent simultaneous recording and reproduction, which improves the performance of the recording and reproducing apparatus and increases its value to the user."

In response, Applicants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Yamamoto by the alleged teaching of Thomason in relation to claims 1, 9, and 55. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification.").

Applicants maintain that the Examiner has not made any showing of where the prior art suggests "time division control means for controlling the transmitting and reading of the second compressed data to and from the recording means in a time division manner" for the purpose of "simultaneous recording and reproduction". Indeed, the Examiner appears to have learned of this advantage from Applicants' specification, which recites the following object of the invention on page 3, lines 6-8: "An object of the present invention is to provide an apparatus for recording and reproducing digital data, which is capable of recording digital broadcast data while reproducing

previously- recorded digital broadcast data.” In support of Applicants’ position, see *In re Vacck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (reversing the Board’s obviousness rejections, and noting that the primary reference failed to suggest the modification alleged to be obvious, and stating that “the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant’s disclosure.”)

Based on the preceding arguments, Applicants respectfully maintain that claim 1 is not unpatentable over Yamamoto in further view of Thomason, and that claims 1, 9, and 15 is in condition for allowance. Since claims 2-7 depend from claim 1, Applicants contend that claims 2-7 are likewise in condition for allowance. Since claims 10-14 depend from claim 9, Applicants contend that claims 10-14 are likewise in condition for allowance. Since claims 16-20 depend from claim 15, Applicants contend that claims 16-20 are likewise in condition for allowance.

In addition with respect to claims 3, 11, and 16, Applicants maintain that Yamamoto in further view of Thomason does not teach or suggest the feature: “wherein a **plurality** of said MPEG2-PES data is recorded by the recording means as one stream of data” (emphasis added).

The Examiner quotes Yamamoto, col 7, lines 27-29 as reciting: “the PES packet storage block records the audio or video PES packet output by the demultiplexer unit 3, in the A/V-HDD”.

In response, Applicants contend that the preceding quote from Yamamoto discusses only a single PES packet, which does not satisfy the limitation of “a **plurality** of said MPEG2-PES data”, as required by claims 3, 11, and 16.

In addition with respect to claims 4, 13, and 17, Applicants maintain that Yamamoto in further view of Thomason does not teach or suggest the feature: "further comprising reproduction control means for reading the second compressed data from the recording means and transmitting the second compressed data to the data reproducing means" (emphasis added).

The Examiner quotes Yamamoto, col 8, line 66 - col. 9, line 4 as reciting: "the navigation control block 22 instructs the data transfer to the PES packet reading block 21 according to an available space in the PES packet buffer 23. The PES packet reading block 21 extracts an audio or video PES packet from the A/V-IHDD 1 (10), and output the PES packet data to the PES packet buffer 23".

In response, Applicants contend that the preceding quote from Yamamoto does not disclose that the navigation control block 22 reads the second compressed data data from the recording means. Furthermore, the preceding quote from Yamamoto does not disclose that the navigation control block 22 transmits the second compressed data to the data reproducing means (which the Examiner alleges is the AV decoder 24 of Yamamoto in the Examiner's analysis of claim 1).

In addition with respect to claims 5, 14, and 18, Applicants maintain that Yamamoto in further view of Thomason does not teach or suggest the feature: "monitoring means for monitoring the amount of data transmitted from the reproduction control means to the data reproducing means".

The Examiner quotes Yamamoto, col 8, line 66 - col. 9, line 1 as reciting: "the navigation control block 22 instructs the data transfer to the PES packet reading block 21 according to an

available space in the PES packet buffer 23".

In response, Applicants refer to previous arguments by the Examiner in order to apply a logically consistent review of the Examiner's analysis of claims 5, 14, and 18. The Examiner alleges that the navigation control block 22 of Yamamoto represents the "monitoring means" in the Examiner's analysis of claim 5. The Examiner alleges that the navigation control block 22 of Yamamoto represents the "reproduction control means" in the Examiner's analysis of claim 4. The Examiner alleges that the AV decoder 24 of Yamamoto represents the "data reproducing means" in the Examiner's analysis of claim 1.

In application to claim 5 with logical consistency, the Examiner is therefore arguing that Yamamoto discloses navigation control block 22 for monitoring the amount of data transmitted from the navigation control block 22 to the AV decoder 24, which Yamamoto most certainly does not disclose.

Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 5, 14, and 18.

In addition with respect to claims 6 and 19, Applicants maintain that Yamamoto in further view of Thomason does not teach or suggest the feature: "selecting means for selectively transmitting the compressed audio/video data extracted by the data separating means to the data reproducing means" (emphasis added).

The Examiner quotes Yamamoto, col 5, lines 28-31, as reciting: "The user interface control block 25 receives a playback command for normal play or trick play, entered by a user, and outputs the entered playback command for normal play or trick play to the navigation control

block 22",

In response, Applicants refer to previous arguments by the Examiner in order to apply a logically consistent review of the Examiner's analysis of claims 6 and 19. The Examiner alleges that the user interface control block 25 of Yamamoto represents the "selecting means" in the Examiner's analysis of claim 5. The Examiner alleges that the demodulation/error correction unit 3 of Yamamoto represents the "data separating means" in the Examiner's analysis of claim 1. The Examiner alleges that the AV decoder 24 of Yamamoto represents the "data reproducing means" in the Examiner's analysis of claim 1.

In application to claim 6 with logical consistency, the Examiner is therefore arguing that Yamamoto discloses user interface control block 25 for selectively transmitting the compressed audio/video data extracted by the demodulation/error correction unit 3 to the AV decoder 24, which Yamamoto most certainly does not disclose.

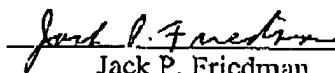
Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 6 and 19.



CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457.

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